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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,054	01/15/2002	Etienne Georges Maze	003744-02	2937
7590	01/14/2004			
Brenda L. Havel Metal Coatings International Inc. 275 Industrial Parkway Chardon, OH 44024			EXAMINER LAVILLA, MICHAEL E	
			ART UNIT 1775	PAPER NUMBER

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

2010

# Office Action Summary

Application No.

10/045,054

Applicant(s)

MAZE ET AL.

Examiner

Michael La Villa

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I, Claims 1-9, in Paper No. 9 is acknowledged.
2. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
4. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1, 5, 7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.  
  
Regarding Claim 1, it is unclear where the claimed flake alloy is taught. Rather, flakes having about 80 weight percent Zn and about 20 weight percent Al are taught. Regarding Claim 7, it is unclear where the claimed alloy flake, having an unspecified amount of zinc in a paste that contains 4-5 percent aluminum and 7-10 percent paste liquid, is taught.
6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
7. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- I. Regarding Claim 6, it is unclear what is meant by the phrase "both basis 100 weight percent of said paste, wherein said paste contains less than about 15 weight percent aluminum in said alloy flake on said metals basis, and up to about 10 weight percent paste liquid, basis weight of said paste." It is unclear how the content of aluminum and zinc can be considered to be 100 weight percent of a paste when the paste is also described as containing liquid.
- II. Regarding Claim 7, it is unclear what is meant by the phrase "a paste containing from about 4 to about 5 weight percent of aluminum in said alloy flake, and from about 7 to about 10 weight percent of paste liquid, both basis 100 weight percent of said paste, wherein said paste contains less than about 15 weight percent aluminum in said alloy flake, on a metals basis, and up to about 10 weight percent paste liquid, basis weight of said paste." Should the underlined reference to "both" also include the amount of zinc or not? Does the underlined reference to paste liquid further limit the previous requirement of 7 to 10 percent paste liquid or is it superfluous?
- III. Regarding Claim 8, it is unclear what is meant by the phrase "STAPA 4ZnAl7." It appears to signify a trademark designation which would be

indefinite since its meaning may vary over time. Applicant suggests that its meaning is clear because its composition as of the time of filing the application is specified in the Specification. Since the composition of the commercial paste may be changed, the claim is indefinite. The claim can be rendered definite by replacing the trademark designation with the described composition of the Specification.

- IV. Regarding Claims 1, 2, 4, 6, 7, and 8, it is unclear what is being admitted as the composition of the prior art. Applicant describes a "composition [that] contains particulate metal in a liquid medium" that is adapted for application to and curing on a substrate. It is unclear whether the claimed "liquid medium" is a substance to be cured or not necessarily. Does "liquid medium" only describe a physical state of a material in which the particulate metal is to be incorporated? It is unclear whether applicant's claim is to be interpreted as implicitly containing a substance in the coating composition, in addition to the particulate metal, that is to be cured. It is unclear whether the admitted curing is necessarily organic in nature, as, for example, the disclosed silanes, or not.

#### ***Response to Amendment***

- I. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejections of the Office Action

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mailed on 31 July 2003. Except as repeated above for the reasons given above, the rejections are withdrawn.

- II. In view of applicant's amendments and arguments, applicant traverses the section 103 rejection over Orr and over Orr in view of Ishijima of the Office Action mailed on 31 July 2003. Rejection is withdrawn.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Michael La Villa  
9 January 2004

